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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/690,115

10/21/2003

Richard L. Apodaca

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02/27/2008

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EXAMINER

COLEMAN, BRENDA LIBBY

ART UNIT

PAPER NUMBER

1624

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/690,115	<b>Applicant(s)</b> APODACA ET AL.	
	<b>Examiner</b> Brenda L. Coleman	<b>Art Unit</b> 1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,4,41-43,47-53,59 and 61-80 is/are pending in the application.
- 4a) Of the above claim(s) 47-50 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 61-63 and 71 is/are allowed.
- 6) ☒ Claim(s) 1,42,43,51-53,59,64-70,72 and 75 is/are rejected.
- 7) ☒ Claim(s) 4,41,73,74 and 76-80 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/13/07 &amp; 2/14/08</u> .                                  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

Claims 1, 4, 41-43, 47-53, 59 and 61-80 are pending in the application.

This action is in response to applicants' amendment filed January 24, 2008.

Claim 1 has been amended, claims 2, 3, 22, 23, 25-30, 56-58 and 60 have been canceled and claims 64-80 have been added.

### *Response to Amendment*

Applicant's amendments filed January 24, 2008 have been fully considered with the following effect:

1. The applicant's amendments and arguments are sufficient to overcome the 35 USC § 103, obviousness rejection, labeled paragraph 1) maintained in the last office action, which is hereby **withdrawn**.
2. The applicant's amendments and arguments are sufficient to overcome the 35 USC § 112, first paragraph rejection, labeled paragraph 4) in the last office action, which is hereby **withdrawn**.
3. The applicant's amendments and arguments are sufficient to overcome the 35 USC § 112, first paragraph rejection, labeled paragraph 5) in the last office action, which is hereby **withdrawn**.
4. The applicant's amendments and arguments are sufficient to overcome the 35 USC § 112, second paragraph rejections, labeled paragraph 5) in the last office action, which are hereby **withdrawn**.

5. With regards to the provisional obviousness-type double patenting rejection of claims 1, 22, 23, 25-30, 42, 43, 51-53 and 56-59 in the previous office action, the applicants' arguments have been considered but are not found persuasive. The applicants' stated that if all the grounds of rejection are withdrawn and the claims are otherwise in condition for allowance, then the obviousness-type double patenting rejection would also be withdrawn. However in view of the new grounds of rejection necessitated by amendment set forth below the claims are not in condition for allowance at this time and thus the rejection is herein maintained.

Claims 1, 42, 43, 51-53, 59 and 64-70 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-29 of copending Application No. 11/531,849, for reasons of record and stated above.

In view of the amendment dated January 24, 2008, the following new grounds of rejection apply:

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

6. Claims 64-70, 72 and 75 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

a) Claim 64 and claims dependent thereon are vague and indefinite in that claim 64 is a duplicate of claim 59 where claim 1 is limited to C<sub>3-8</sub>cycloalkyl in the definition of R<sup>1</sup>.

- b) Claim 72 is vague and indefinite in that claim 72 is a duplicate of claim 4 where claim 1 is limited to isopropyl in the definition of R<sup>1</sup>.
- c) Claim 75 is vague and indefinite in that claim 75 is a duplicate of claim 74 where R<sup>1</sup> is isopropyl; R<sup>2</sup> is hydrogen; R<sup>3</sup> is hydrogen and Q is morpholinyl.

#### ***Election/Restrictions***

7. This application contains claims 47-50 drawn to an invention nonelected with traverse in the reply filed on March 16, 2006. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

#### ***Claim Objections***

8. Claims 4, 41, 73, 74 and 76-80 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. None of the prior art of record or a search in the pertinent art area teaches the compounds, compositions and method of use of the compounds of formula I as claimed herein.

#### ***Allowable Subject Matter***

9. Claims 61-63 and 71 are allowed. None of the prior art of record or a search in the pertinent art area teaches the compounds of formula I and species as claimed herein.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda L. Coleman whose telephone number is 571-272-0665. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Art Unit: 1624

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brenda L. Coleman/  
Primary Examiner, Art Unit 1624